

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: SHEMI, Amotz et al.
Serial Number: 10/590,053
Filed: August 21, 2006, as a National Phase Application of PCT International Application No. PCT/IL2005/000208, filed on February 20, 2005
For: SYSTEM AND METHOD FOR THE FABRICATION OF AN ELECTRO-OPTICAL MODULE
Group Art Unit: Not Assigned
Examiner: Not Assigned
This Communication Submitted: April 2, 2008

Mail Stop PCT
Hon. Commissioner for Patents
Office of PCT Legal Administration
P.O. Box 1450
Alexandria, VA 22313-1450

RENEWED PETITION TO REVIVE UNINTENTIONALLY ABANDONED APPLICATION UNDER 37 C.F.R. §1.137(B)
AND TO ACCEPT APPLICATION WITHOUT SIGNATURE
OF ONE OF THE INVENTORS UNDER 37 C.F.R. §1.47(A)

Sir:

Applicants Yacov Malinovich and Eli Arad, for themselves and on behalf of co-inventor Dr. Amotz Shemi, hereby respectfully petition the Commissioner under 37 C.F.R. §1.137(b) to revive the above-referenced unintentionally abandoned application, and under 37 C.F.R. §1.47(a) to accord the application status as complete and acceptable in the absence of an oath or declaration of one of the inventors, Dr. Amotz Shemi.

This is a renewal of a petition seeking the same relief filed on December 20, 2007 (the “Original Petition”), which was denied without prejudice in a decision dated February 21, 2008 (the “February 21 Decision”).

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BACKGROUND INFORMATION

With respect to 37 C.F.R. 1.137, the Original Petition was denied for noncompliance with the requirements of 37 C.F.R. 1.137(b)(3). The February 21 Decision stated that the materials submitted explained the delay for the period from about August 30, 2007 until December 20, 2007, but there was no explanation for the delay in filing a response to avoid abandonment (due June 20, 2007). A statement was required by counsel of record at the time of abandonment indicating whether the delay was unintentional.

With respect to 37 C.F.R. 1.47(a), the Original Petition was denied on the ground that the declaration of the inventors other than Dr. Shemi appeared to be a composite created from a combination of separate declarations signed by the inventors or from incomplete declarations presented to the inventors, and was therefore defective. The Original Petition was denied on the further ground that it did not demonstrate that Dr. Shemi had been presented a complete copy of the application for his signature, in the absence of which, a petition under 37 C.F.R. 1.47(a) purportedly could not be granted.

The requirements under 37 C.F.R. 1.47(a) for the petition fee and for the last known address of the non-signing inventor were deemed to have been satisfied by the Original Petition.

The documents submitted herewith and the discussions below are believed to remedy the purported deficiencies in the Original Petition.

ADDITIONAL SUPPORTING DOCUMENTS SUBMITTED HEREWITH

Attachment (1): A single complete Declaration for the present application signed by Yacov Malinovich and Eli Arad, two of the three inventors of the subject matter of this application;

Attachment (2): Declaration of Yosi Barkai, a partner of the law firm of Pearl Cohen Zedek Latzer, the attorneys of record in this application at the time of abandonment (the “Barkai Declaration”);

Attachment (3): Declaration of Shai Belzer, Chief Financial Officer of ColorChip Ltd.. (“ColorChip”), the company by whom the inventors were employed when the invention was made, concerning the abandonment of the application (“Belzer Declaration I”);

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Attachment (4): Declaration of Shai Belzer concerning further attempts to present the non-signing inventor with a complete copy of the application, and the non-signing inventor's response to those attempts ("Belzer Declaration II").

DISCUSSION

Regarding the Requirements of 37 C.F.R. 1.137:

The accompanying Barkai Declaration, Belzer Declaration I, and the materials submitted in the Original Petition clearly state and demonstrate that the abandonment of this application was unintentional for the entire period from the date of abandonment (June 20, 2007) up to the date of filing of the original petition on December 20, 2007, and from that date to the date of filing of this grantable Renewed Petition to Revive under to 37 C.F.R. 1.137(b).

The accompanying declaration signed by Messrs. Malinovich and Arad, two of the three inventors (Attachment (1)), is in proper form, and overcomes the deficiency noted in the February 21 Decision. It is respectfully submitted that Attachment (1) is a proper and complete response to the Notification of Missing Requirements as to inventors Malinovich and Arad, and that the aspect of this Renewed Petition under 37 C.F.R. 1.47(a), and accompanying Attachments (1) and (4) constitute a proper and complete response to the Notification as to Dr. Shemi.

Regarding the Requirements of 37 C.F.R. 1.47(a):

The new declaration of the inventors other than Dr. Shemi is in proper form, and in full compliance with all applicable requirements, as noted in the previous paragraph.

Belzer Declaration II and its accompanying exhibits demonstrate that Mr. Belzer sent a package containing a complete copy of this application to Dr. Shemi at his last known address via the Courier Service of the Israel Post Office on March 18, 2008 (¶3), that no one was available to receive the package when attempts were made to deliver it on March 19, 2008 and again on March 23, 2008 (¶4), that on both occasions, a notice was attached to Dr. Shemi's front door requesting that he contact the post office to arrange to receive the package (¶4), that there was no response to the two notices left on Dr. Shemi's door, and that on March 31, the Israel Post Office returned the package to ColorChip as undeliverable (¶6).

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Belzer Declaration II further demonstrates that Mr. Belzer spoke to Dr. Shemi by telephone on March 25, 2008, and again requested that he cooperate and sign the Inventor Declaration, but that Dr. Shemi explicitly refused, and told Mr. Belzer to “stop bothering him, as he will not sign any documents” (¶5).

It is respectfully submitted that the activities, events, and circumstances documented in Belzer Declaration II, in the supporting materials accompanying the original petition, (and mentioned incidentally in paragraph 7 of Belzer Declaration I and in paragraph 6 of the Barkai Declaration), all clearly demonstrate that the requirements of 37 C.F.R. 1.47(a) are fully satisfied, even though there is no direct evidence that a complete copy of the application was actually delivered to Dr. Shemi.

There is no requirement under 37 C.F.R. 1.47(a) that a complete copy of the application be presented to a non-signing inventor before a petition can be granted. The rule only requires proof that “. . . a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort.” Here, the evidence submitted proves not only that Dr. Shemi has repeatedly refused to join in the application, and expressly did so again as recently as March 25, 2008, but also that he ignored two requests by the Israel Post Office that he make arrangements to receive a copy of the application.

Moreover, even M.P.E.P. Section 409.03(d) cited in the February 21 Decision, does not require actual delivery of a complete copy of the application. For example, an exception is made when “. . . it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers.” Particularly in light of Dr. Shemi’s numerous prior refusals to sign the declaration for this application, the conversation between Mr. Belzer and Dr. Shemi described in paragraph 5 of Belzer Declaration II demonstrates that Dr. Shemi understood exactly what he was being asked to sign, that he did not intend to sign anything and that he did not even want to receive the application papers.

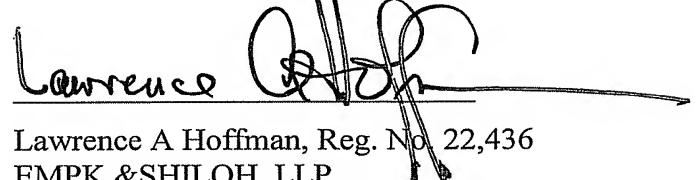
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In view of the foregoing, favorable reconsideration of this renewed petition, revival of this application, and acceptance of the application for examination without Dr. Shemi's signed declaration are respectfully solicited.

Date: April 2, 2008

Respectfully submitted,

Yacov MALINOVITZ et al


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